

REMARKS

I. Claim Status

Claims 1-117 are pending. The Examiner has withdrawn claims 25-78 and 108-117 as non-elected in response to the Office Action (Restriction/Election Requirement) of December 14, 2006. The specification has been amended to identify the foreign applications to which the present application claims priority. No claims are amended herein.

Applicants respectfully acknowledge that the Examiner has withdrawn the rejection of claims 1-24 and 79-107 under 35 U.S.C. § 103(a) over U.S. Patent No. 6,875,245. See Dec. 3, 2008, Office Action at 2. Applicants further respectfully acknowledge that the Examiner has withdrawn the election of species directed to a specific tacky wax. See *id.*

II. Priority

Applicants wish to point out that this application claims the benefit of the filing date of:

- (1) French Patent Application No. 02 11096, filed September 6, 2002;
 - (2) French Patent Application No. 02 11097, filed September 6, 2002;
 - (3) French Patent Application No. 02 11104, filed September 6, 2002;
 - (4) French Patent Application No. 02 12097, filed September 30, 2002; and
 - (5) French Patent Application No. 02 12098, filed September 30, 2002
- (collectively, "French priority documents"), as demonstrated by the submissions on

September 5, 2003 (Applicants submitted a Claim for Priority to these French priority documents, and also submitted certified copies of the French priority documents).

To date, the Examiner has not acknowledged receipt of the certified French priority documents. Thus, Applicants respectfully request that the Examiner acknowledge receipt of the certified French priority documents in the next paper from the Office.

III. Rejections Under 35 U.S.C. § 112

A. Rejection Under 35 U.S.C. § 112, ¶ 1

The Examiner rejects claims 1-10, 12-24, and 79-107 under 35 U.S.C. § 112, ¶ 1, as allegedly failing to comply with the written description requirement. See the detailed reasons stated in the Dec. 3, 2008, Office Action at 2-6.

Applicants respectfully disagree. The comparative testing presented in paragraph [0161] demonstrates that a single embodiment of the claimed invention having a tacky wax falling within the claim scope possesses the best combination of physical properties (i.e., stability, viscosity, and consistency) compared to five compositions, each of which did not possess a tacky wax falling within the claim scope. See Specification as-filed at ¶¶ [0162]-[0163]. The facts that the five comparative waxes fall outside the scope of the claims and that potentially some of the other 19 waxes listed by the Examiner may fall outside the scope of the claims is of no import to the question of whether the specification provides adequate written description support for the claims.

Rather, the question to be answered for written description support is whether the specification “describe[s] the claimed invention is sufficient detail that one skill in the art can reasonably conclude that the inventor had possession of the claimed invention.” M.P.E.P. § 2163(I) (citations omitted). In the present case, paragraphs [0026] to [0036] of the specification provides great detail about the claimed tacky waxes and how one of skill in the art could test whether a certain wax is a tacky wax having the claimed tack and hardness. See Specification as-filed at ¶¶ [0033]-[0035]. The tests provided in the specification, coupled with the comparative testing and examples, clearly establish that one of skill in the art would readily recognize that the inventors were in possession of the claimed invention, including the at least one tacky wax with the claimed tack and hardness, and that one can readily perform the described testing to identify other such tacky waxes.

The Examiner relies on a number of cases pertaining to written description support, but most of them are directed to biotech inventions involving a higher level of unpredictability. Therefore, establishing written description support for a broad genus directed to such biotech inventions may be more relatively difficult to establish than for the claimed compositions reciting waxes. That is particularly so since the specification provides detail for selecting which waxes fall within the claim and which do not, and the specification also provides numerous detailed examples of a claimed composition having a tacky wax falling within the claim scope. See Specification as-filed at Examples 1 and 7-15.

Applicants thus respectfully submit that the Examiner withdraw the rejection.

B. Rejection Under 35 U.S.C. § 112, ¶ 2

The Examiner also rejects claim 107 under 35 U.S.C. § 112, ¶ 2 as allegedly being indefinite. See Dec. 3, 2008, Office Action at 6. Specifically, the Examiner questions what is meant by “care compositions.” *Id.* The Examiner further questions whether the “care composition [is] for skin or nail or hair.” *Id.*

Applicants respectfully traverse this rejection for the following reasons.

Applicants submit that one of skill in the art would readily understand that the care composition, as claimed, can be used, for example, on the skin, the nails, the eyelashes, the eyebrows, and the hair. See Specification as-filed at ¶ [0002] (Disclosing that the claimed cosmetic composition may be used, for example, “in the field of makeup or care of human keratin materials such as the skin, the nails, the eyelashes, the eyebrows and the hair. Also disclosed herein is a cosmetic care or makeup process for keratin materials.”). Thus, one of skill in the art would understand from reading the specification the meaning of “care compositions,” and, therefore, that term is not indefinite.

Applicants respectfully request that the Examiner withdraw this rejection.

IV. Rejection Under 35 U.S.C. § 103

The Examiner rejects claims 1-24 and 79-107 under 35 U.S.C. § 103(a) as allegedly being unpatentable over the combination of U.S. Patent Nos. 5,985,298 to Brieva et al. (“Brieva”) and 5,783,176 to Meiring et al. (“Meiring”). See the detailed reasons in Dec. 3, 2008, Office Action at 6-8. Essentially, the Examiner concludes that it would have been obvious to make compositions of Brieva and substitute synthetic

bees wax for bees wax or synthetic wax. *See id.* at 8. Furthermore, the Examiner concludes that it would have been obvious to substitute the synthetic beeswax of Brieva with the ester of Meiring. *See id.*

Applicants respectfully traverse this rejection for at least the following reasons.

With respect to obviousness, several basic factual inquiries must be made in order to determine the obviousness or non-obviousness of claims under 35 U.S.C. § 103. These factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966), require the Examiner to:

- (1) Determine the scope and content of the prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

The obviousness or nonobviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. at 467; *see also KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1730, 82 U.S.P.Q.2d 1385, 1388 (2007).

Indeed, to establish a *prima facie* case of obviousness, the Examiner must:

make a determination whether the claimed invention “as a whole” would have been obvious at that time to that person. Knowledge of applicant’s disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the “differences,” conduct the search and evaluate the “subject matter as a whole” of the invention.

M.P.E.P. § 2142. “The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.”

Id. It is important to note, moreover, that the prior art references relied upon in a

rejection “must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention.” M.P.E.P. § 2141.03(VI); *see also Graham*, 383 U.S. at 17, 148 U.S.P.Q. at 467.

The Examiner has not established a *prima facie* case of obviousness because the claimed invention as a whole would not have been obvious over Brieva in view of Meiring, when the references are considered as a whole. Specifically, neither of the references teaches or suggests a composition comprising the claimed at least one tacky wax, as defined in the claim, in the claimed amount of at least 27% by weight, relative to the total weight of the composition. Moreover, the claimed composition comprising the at least one tacky wax produces an unexpected result that Brieva and Meiring fail to recognize.

To begin with, Applicants acknowledge that Brieva broadly discloses mascara compositions having 0.1-30% wax. *See* Brieva, col. 5, lines 41-53. Applicants further acknowledge that Brieva discloses that “suitable” waxes include

natural and synthetic waxes such as bayberry wax, beeswax, candelilla wax, carnauba, ceresin, cetyl esters, hydrogenated jojoba oil, hydrogenated jojoba wax, hydrogenated rice bran wax, japan wax, jojoba butter, jojoba oil, jojoba wax, lanolin wax, microcrystalline, mink, montan acid, montan, ouricury, ozokerite, rice bran, shellac, synthetic beeswax, and synthetic wax, etc.

Id. at col. 5, lines 58-65. Brieva, however, says nothing about the tack and hardness of those waxes and also nothing about whether the disclosed mascara compositions contain at least 27% of at least one tacky wax as claimed.

The Examiner points to Example 2 of Brieva arguing that the waxes fall within the claimed amount. Applicants respectfully disagree. Example 2 discloses a mascara

composition containing, *inter alia*, carnauba wax (4.25%), candelilla wax (9.25%), beeswax (4.60%), and synthetic wax (4.85%). See *id.* at col. 7, lines 62-65. These waxes add up 22.95% wax present in the disclosed mascara composition, which is less than the claimed amount of at least 27% of at least one tacky wax.

Furthermore, as noted in the comparative testing presented in the instant specification, beeswax, one of the waxes in Example 2 of Brieva, does not even have the claimed tack and hardness. See Specification as-filed at ¶ [0161]. Moreover, it is the undersigned's understanding that carnauba wax and candelilla wax, two other waxes used in Example 2 of Brieva, have tacks of 0 N.s and hardnesses of 6.88 MPa and 9.59 MPa, respectively. Both of these waxes, therefore, also do not have the claimed tack and hardness.

The "synthetic wax" used in Example 2 of Brieva may encompass a number of different waxes, including, for example, microcrystalline wax (e.g., Microwax HW from Paramelt), which has a tack of 0 N.s and a hardness of 8.11 MPa. Therefore, the "synthetic wax" may also fall outside the claimed tack and hardness and certainly does not necessarily and inevitably fall within the claimed tack and hardness.

In other words, the carnauba wax, candelilla wax, and beeswax do not have the claimed tack and hardness. So even if the synthetic wax somehow fell within the claim scope for tack and hardness, at most Example 2 of Brieva would have 4.85% wax, which teaches away from the required at least 27% amount in the claims. And as noted, there are synthetic waxes that do not have the claimed tack and hardness. For those cases, Example 2 of Brieva teaches 0% waxes that have the claimed tack and

hardness. It is hard to imagine a more compelling case of teaching away. Nothing in Meiring cures those deficiencies of Brieva.

Accordingly, one of ordinary skill in the art would not have been guided by Brieva and Meiring, either alone or in combination, to make the claimed composition having at least one tacky wax with the claimed tack and hardness in the claimed amount. In fact, those documents teach away from the claimed invention.

Finally, as discussed above, the instant specification provides comparative testing demonstrating that a single mascara composition comprising at least one tacky wax falling within the claim scope (i.e., Example 1) has the best combination of physical properties (e.g., stability, viscosity, and consistency) compared with five mascara compositions containing waxes falling outside the scope of the claims.

See Specification as-filed at ¶¶ [0184]-[0193]. Such testing establishes unpredictability in the choice of wax, leading to benefits not recognized or predicted by the prior art, including Brieva and Meiring.

In making that argument, Applicants are not making any admission that the Examiner has established a *prima facie* case of obviousness. To the contrary, as just explained, no such *prima facie* case has been established. The testing, as mentioned, shows unpredictability with respect to the waxes and their amounts, further demonstrating that there is no *prima facie* case of obviousness.

Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness and the rejection should be withdrawn.

V. Double Patenting Rejection

Claims 1-24 and 79-107 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-31 and 73-100 of copending Application No. 10/654,887. See Dec. 3, 2008, Office Action at 8-9. Applicants presently agree with the double patenting rejection and plan to file an appropriate Terminal Disclaimer when allowable subject matter is indicated.

CONCLUSION

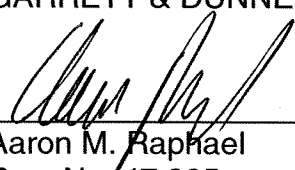
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

If there is any fee due in connection with the filing of this Statement, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: January 26, 2009

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